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Application No.: 10/701,990  
Response to Office Action of January 24, 2007

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Docket No.: 416272005200

**REMARKS**

Claims 1-66 remain pending in the present application. Claims 33, 36, and 44-66 are withdrawn from consideration. Claims 1-32, 34, 35, and 37-43 remain pending for examination.

**Restriction/Election Requirement**

Applicant acknowledges that the Restriction Requirement of September 25, 2006, has been made final.

**IDS**

The Examiner has commented on the quantity and nature of the IDS references submitted by the Applicant. Further, the Examiner has requested that Applicant specifically point out references of particular pertinence and that the Applicant inform the Examiner of all related cases, pending, allowed, or abandoned, that are directed to the presently elected invention.

Applicant takes very seriously the duty of disclosure under 37 CFR 1.56. Accordingly, Applicant has endeavored to fulfill this duty to the utmost of Applicant's ability. Applicant does not presume to identify what the Examiner would or would not find to be pertinent references. Further, Applicant is unaware of a requirement, at this time, to specifically point out the most pertinent references.

With respect to the request for information as to related cases, Applicant provides, as Attachment A, a listing, as far as the undersigned can determine, of all U.S. patent cases, pending, allowed, or abandoned, that name Marc Hellerstein, the inventor in this application, as an inventor and are assigned to the Regents of the University of California. Applicant further notes that several of the references submitted in the IDS's discussed above, were authored or co-authored by Marc Hellerstein. Respectfully, Applicant does not state whether any of these cases are "directed to the presently elected invention," for the reasons stated above.

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**Nonstatutory Double Patenting**

Claims 1-32, 34-35, and 37-43 have been provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-36 of co-pending Pub. No. US 2006/0020440 A1 (App. No. 11/064,197, filed February 22, 2005). Applicant notes that the present application, of the two, is the earlier filed application. If the Examiner finds that this rejection is the only remaining rejection, in view of Applicant's remarks, Applicant requests that this rejection be withdrawn in accordance with MPEP 804(I)(B)(1). Applicant reserves the right to substantively traverse this provisional rejection, either in the present application or in App. No. 11/064,197.

Claims 1-32, 34-35, and 37-43 have been provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-16 of co-pending App. No. US 2006/0280682 A1 (App. No. 11/451,735, filed June 12, 2006). Applicant notes that the present application, of the two, is the earlier filed application. If the Examiner finds that this rejection is the only remaining rejection, in view of Applicant's remarks, Applicant requests that this rejection be withdrawn in accordance with MPEP 804(I)(B)(1). Applicant reserves the right to substantively traverse this provisional rejection, either in the present application or in App. No. 11/451,735.

**Rejection- 35 U.S.C. § 102(a)**

Claims 1-32, 34, 35, and 37-43 are rejected under 35 U.S.C. § 102(a) as being anticipated by US 2005/0238581 A1 ("Kurland *et al.*"). Applicant notes that the October 27, 2005, publication date of Kurland *et al.*, in comparison to at least the November 4, 2003, filing date of the present application, disqualifies it as 102(a) prior art. Applicant respectfully requests that this basis for rejection be withdrawn.

While the Examiner has not raised a 35 U.S.C. § 102(e) rejection, in the interests of furthering prosecution, Applicant will address Kurland *et al.* as a potential 102(e) reference with respect to claims 1-32, 34, 35, and 37-43. The Examiner asserts that Kurland *et al.* teaches the administration of <sup>2</sup>H-labeled glucose (Kurland *et al.* at paragraph 72) and a glucose tolerance test

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(Kurland *et al.* at paragraphs 91-92). However, Kurland *et al.* fails to teach or suggest the measurement of  $^2\text{H}$  incorporation into water, a metabolic product of sugar or fatty acid metabolism, as required in at least step (c) of claim 1. Rather, Kurland *et al.* traces  $^2\text{H}$  label through mass fragmentography of the C1-C4 (when employing  $[2-^2\text{H}]\text{-glucose}$ ) and the C3-C6 (when employing  $[6, 6-^2\text{H}_2]\text{-glucose}$ ) fragments of glucose. Kurland *et al.* at paragraph 92. Accordingly, the methods of Kurland *et al.* fundamentally differ from the claimed methods of the present application. Claims 2-32, 34, 35, and 37-43 of this application depend from claim 1 and are novel in view of Kurland *et al.* for at least the reasons stated for claim 1. Applicant respectfully asserts that Kurland *et al.*, if asserted as a 102(e) reference, would not anticipate any of the pending claims.

#### Objections- Title and Abstract

The Examiner has required a new title on the basis that the present title is not descriptive. The Examiner has also objected to the abstract for not being directed to the elected invention. For clarity, Applicant will address the objection to the abstract first.

The Examiner states that the abstract is not directed to the elected invention. Applicant notes that under 37 C.F.R. 1.72 the abstract is a brief statement of the technical disclosure of the specification. Applicant asserts that the present abstract is just such a statement. Applicant is unaware of any requirement, under the CFR or MPEP, for the abstract to be corrected to match an election in response to a restriction requirement or species election requirement. Further, Applicant notes that claim 1 of the elected group is generic. Should claim 1 be found allowable, Applicant reserves the right to request rejoinder under MPEP 809.02. Accordingly, the scope of the elected invention may or may not change in the present application. Applicant respectfully asserts that the objection to the abstract is improper or at least premature. Applicant requests that the objection be withdrawn.

Regarding the requirement for a new title, Applicant respectfully does not understand how the present title is not descriptive of the claimed invention. Applicant presumes that this requirement is related to the objection to the abstract, discussed above. While the Examiner has not

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stated specific reasons why the title is not descriptive, Applicant presumes that it is related to the inclusion of the terms "Fat" and "Fatty Acids" which reference a non-elected species of generic claim 1. Applicant refers again to the possibility of rejoinder, upon a finding of allowability of generic claim 1. Applicant respectfully asserts that the requirement for a new title is improper or at least premature. Applicant requests that the requirement be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 416272005200. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: July 20, 2007

Respectfully submitted,

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**Attachment A**

Status	Appln No.	Appln Date
Granted	08/857,007	5/15/1997
Granted	09/075,309	5/8/1998
Granted	09/440,596	11/15/1999
Granted	10/155,536	5/24/2002
Granted	10/279,399	10/23/2002
Pending	10/366,125	2/12/2003
Pending	10/407,435	4/4/2003
Allowed	10/519,121	9/15/2003
Pending	10/523,250	7/25/2003
Pending	10/526,860	9/4/2003
Pending	10/684,513	9/16/2003
Pending	10/701,990	11/4/2003
Allowed	10/872,280	6/17/2004
Granted	10/944,154	9/16/2004
Pending	10/963,967	10/12/2004
Pending	10/997,323	11/23/2004
Pending	11/064,197	2/22/2005
Pending	11/078,083	3/11/2005
Pending	11/094,387	3/29/2005
Pending	11/185,610	7/19/2005
Pending	11/233,549	9/22/2006
Pending	11/416,842	5/2/2006
Pending	11/433,879	5/11/2006
Pending	11/451,735	6/12/2006
Pending	11/796,438	4/28/2007
US	60/335,029	10/24/2001
US	60/356,008	2/12/2002
US	60/370,599	4/5/2002
US	60/392,072	6/26/2002
US	60/399,950	7/30/2002
US	60/408,346	9/4/2002
US	60/410,352	9/13/2002
US	60/411,029	9/16/2002
US	60/423,964	11/4/2002
US	60/484,626	7/3/2003
US	60/525,261	11/25/2003
US	60/525,261	11/25/2003
US	60/546,580	2/20/2004
US	60/552,675	3/11/2004
US	60/557,734	3/29/2004
US	60/581,028	6/17/2004
US	60/677,672	5/3/2005
US	60/689,612	6/10/2005

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